



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,996	04/05/2002	Tatsuji Nagaoka	9683/112	5819
7590 08/11/2006			EXAMINER	
Brinks Hofer Gilson & Lione			LE, KHANH H	
P O Box 10395			ART UNIT	
Chicago, IL 60610			PAPER NUMBER	
			3622	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/089,996	Applicant(s) NAGAOKA ET AL.	
	Examiner Khanh H. Le	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 5/18/2006

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final. (*Restriction only*)

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)

Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Election/Restriction

1a. This Office Action is in response to the Amendment and Response, received May 18, 2006. Following amendment and cancellation of some claims, claims 18-43, 45-46, 48-53 are now presented for examination. Claims 18, 31 and 43 are independent.

1b. RESTRICTION — When Proper

The following is a quotation of an informational statement about restriction requirements:

MPEP 803: RESTRICTION — When Proper

The following is a quotation of an informational statement about restriction requirements:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(I)) or distinct (MPEP § 806.05 - § 806.05(I)). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

37 CFR 1.142 Requirement for restriction:

If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). **Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.**

2. Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 18-30 , drawn to a mobile terminal, classified in class 348, subclass 14.05 or 379.

II. Claim 31-42 , drawn to a method for distributing service incentive to a mobile terminal, classified in class 705, subclass 14.

III. Claim 43, 45-46, 48-53, drawn to a management system for distributing service incentive information to a mobile terminal, classified in class 705, subclass 1.

3. **Inventions I and II** are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)).

In this case invention I, the mobile terminal (such as a PDA) comprising interactive device interface to communicate with an interactive device (such as a television receiver) with interactive device control (e.g. software) to control reception of broadcast and other information via the interactive device (e.g. television receiver) to the mobile terminal and user interface (e.g. buttons) to send user requests, and mobile communication network interface to communicate with a service facility, *can be used to practice another and materially different process such as* to send any type of requests , to any type of facility, and not just the requests to a management system for receipt of incentive information in relation to the broadcast information as claimed in invention II. Apparatus invention I can also be used to practice another and materially different process such as receiving any other type of information and not just a promoted service based on a broadcast information and subsequent request to a particular incentive information management system as claimed in method invention II.

Art Unit: 3622

Because inventions I and II are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. **Inventions I and III** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d). In the instant case, subcombination III, the management system, with user request receiver receiving user request via an interactive device (such as an STB), incentive information generator and transmitter, is separately useable from Subcombination I, the mobile terminal which, as claimed, can send requests to the management system, and not via an interactive device. Thus the subcombinations are distinct because they do not overlap in scope and are not obvious variants. Further, Subcombination I, the mobile terminal, as discussed above in **paragraph** can request any type of information from any type of facility, not just the particular management system claimed in Subcombination III, thus it has separate utility than that of Subcombination III.

Because inventions I and III are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. **Inventions II and III** are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d). In the instant case, subcombination III, the management system, with user request receiver receiving user request via an interactive device (such as an STB) , incentive information generator and transmitter, is separately useable from Subcombination II, a method, which does not need an interactive device (such as an STB) to send a user request to an incentive facility. Thus the subcombinations are distinct because they do not overlap in scope and are not obvious variants. Because inventions II and III are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. **Further, within each Group I and II the following restriction by species is required:**

This application contains claims directed to the following patentably distinct species:

7. **Within Group I: Claims 18-30: Mobile device: The generic claim is claim 18.**

Applicants are required to elect between the following species:

IA. Claims 18-19, 20 or 21 (not both) , 24-30

IA1) claims 18, 19, 20, 24-30

IA2) claims 18, 19, 21 24-30

Art Unit: 3622

IB. Claims 18, 20 or 21 (not both), 22-30

IB1) 18, 20, 22-30

1B2) 18, 21, 22-30

8. IA vs. 1B: Claims 19 and claims 22-23 are different species.

The species are independent or distinct because claim 19 is about user request sent to the TMS via the interactive device while claims 22-23 are drawn to user request sent to the TMS via the mobile communication network. The species are mutually exclusive as represented by different embodiments (see e.g. Figures 5-9 and associated text).

9. 1A1 vs. 1B2: Claims 20 and 21 are different species.

The species are independent or distinct because claim 20 is drawn to the incentive information being received via the interactive device (e.g. set-top box STB) while claim 21 is drawn to the incentive information being received via the mobile communication network. The species are mutually exclusive as represented by different embodiments (see e.g. Figures 5-9 and associated text).

10. Within Group II: Claims 31-42: The generic claim is claim 31.

Applicants are required to elect between the following species:

Art Unit: 3622

IIA.Claims 31-32, 33 or 34 (not both) , 37-42

IIA1) claims 31-32, 33, 37-42

IIA2) claims 31-32, 34, 37-42

IIB. Claims 31, 33 or 34 (not both), 35-42

IIB1) 31, 33, 35-42

IIB2) 31, 34, 35-42

11. IIA vs. IIB: Claims 32 and claims 35-36 are different species.

The species are independent or distinct because claim 19 is about user request sent to the TMS via the interactive device while claims 22-23 are drawn to user request sent to the TMS via the mobile communication network. The species are mutually exclusive as represented by different embodiments (see e.g. Figures 5-9 and associated text).

12. IIA1 vs. IIB2: Claims 33 and 34 are different species.

The species are independent or distinct because claim 20 is drawn to the incentive information being received via the interactive device (e.g. set-top box STB) while claim 21 is drawn to the incentive information being received via the mobile communication network. The species are mutually exclusive as represented by different embodiments (see e.g. Figures 5-9 and associated text).

Art Unit: 3622

13. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Art Unit: 3622

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

14. To summarize, Applicants are required to select one of the following groups or species for prosecution:

Group I, II or III as listed above (see pages 2-3) .

If Applicants select Group I or II, a further election of species is required

If group I: then further choose Group

IA1) claims 18, 19, 20, 24-30;

IA2) claims 18, 19, 21 24-30;

IB1) 18, 20, 22-30; or

1B2) 18, 21, 22-30

Art Unit: 3622

If group II: then further choose Group

IIA1) claims 31-32, 33, 37-42;

IIA2) claims 31-32, 34, 37-42;

IIB1) 31, 33, 35-42; or

IIB2) 31, 34, 35-42.

15. The period for reply to this Restriction requirement is one (1) month.
(See MPEP 809.02(a).)

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 3, 2006


KHL


RAQUEL ALVAREZ
PRIMARY EXAMINER